## *IN THE UNITED STATES PATENT AND TRADEMARK OFFICE*

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| In re application of: Heller et al. | Attorney Docket No.: 101-P288/P3054US1 |
| Application No.: 10/622,017 | Examiner: Nickerson, Jeffrey L. |
| Filed: July 16, 2003 | Group: 2442 |
| Title: METHOD AND SYSTEM FOR DATA SHARING BETWEEN APPLICATION PROGRAMS | Confirmation No. 1693 |

# *PRE-APPEAL BRIEF*

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants appeal the rejection of claims in the final Office Action dated May 28, 2010. Applicants request careful consideration of this Pre-Appeal Brief in advance of Applicant's submission of a formal appeal brief.

## A. Introduction

Claims 1-4, 6, 9, 10, 13-16 and 18-46 are pending. In the final Office Action, rejected claims 1-4, 6, 9, 10, 13-16 and 18-46 under 35 U.S.C. § 103(a). These rejections should be withdrawn for at least the reasons noted below.

## B. Rejection of Claims under 35 USC 103

The Examiner rejected claims 1-4, 6, 9, 10, 13-16, 18-37 and 39-42 under 35 USC 103(a) as being unpatentable over Bowker et al. (US 6,601,071) in view of Dunning et al. (US 2002/0082901); rejected claim 38 under 35 USC 103(a) as being unpatentable over Bowker et al. in view of Dunning et al. and further in view of Berry et al. (US 6,018,341); rejected claim 43 under 35 USC 103(a) as being unpatentable over Bowker et al. in view of Dunning et al. and further in view of Health et al. (US 6,006,034); and rejected claims 44-46 under 35 USC 103(a) as being unpatentable over Bowker et al. in view of Dunning

et al. and further in view of Chow et al. (US 6,029,175). Applicants respectfully disagree.

### 1. Derived Data Communication File – Not Taught or Suggested

Claim 1 pertains to sharing media data between different applications. A first application that uses media information about one or more media content files in a proprietary format can produce a data communication file. The data in the data communication file is derived from the media information such that data internal to the data communication file is acquired from the media information. Thereafter, another different application, a second application program, can access the data communication file to produce a user interface on the display using data internal to the data communication file.

In particular, claim 1, among other things, recites:

> (b) accessing, by a second application program, a data communication file provided by the first application program, the data communication file having a predetermined format known by the second application program, the first application program utilizing media information about one or more media content files in a proprietary format, and the data communication file being derived from the media information such that data internal to the data communication file is acquired from the media information....

Here, a data communication file having a predetermined format is provided by a first application program. The data communication file is derived from media information about one or more media content files in a proprietary format. The second application program understands the predetermined format for the data communication file and can thus access media information about the one or more media content files from the data communication file.

Bowker et al. describes a system that provides an XML import tool that can import data from an XML file. Claim 1, on the other hand, is a method for sharing media data between application programs and thus does not require an import tool such as in Bowker wt al. Therefore, Bowker et al. does not teach or suggest use of a data communication file to access media information about the one or more media content files. Moreover,

claim 1 also recites "wherein the data within the data communication file includes at least media item properties for media items and includes links to storage locations for media content files containing media content for the media items" which is also not taught or suggested by Bowker et al.

On page 5 of the Office Action, referencing paragraphs [0141]-[0142],[0156] of Dunning et al. Dunning et al. describes a system for generating track lists for personalized radio stations. The personalization is based on recommendations based on user profiles of user preferences. The Examiner alleges that "Dunning provides for media items and includes links to storage locations for media content files containing media content for the media items." The Examiner misunderstands the reference. Dunning et al. is referring to links to music-related websites, see para. [0141]. "If desired, such links may be presented to individual users, either on website 106 or via emails 119 that may be periodically generated and transmitted." Dunning et al., para. [0141].

First, it should be noted that the email 119 described in Dunning et al. contains links to music-related websites and has nothing to do with sharing media data between different applications and has no ability to "produce a user interface on the display using data internal to the data communication file." Second, the email 119 of Dunning et al. contain links to music-related websites. Hence, the email 119 does not include "media item properties for media items" nor does it include "links to storage locations for media content files containing media content for the media items." Consequently, even if Dunning were to somehow be combinable with Bowker et al., the combination would not render claim 1 obvious.

### 2. Improper Hindsight Reconstruction

Moreover, the Examiner has fallen victim to impermissible hindsight reconstruction. There is no motivation or suggestion to combine the prior art references to obtain the claimed invention. Rather, such a motivation has been given by the applicant who first realized the problems presented and discovered a viable solution. Using the applicant's teaching to modify a prior art reference is an impermissible use of "hindsight." In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Accordingly, Applicants submit,

notwithstanding the Examiner's assertion to the contrary, that there is no reasonable rationale why anyone skilled in the art would reasonably seek to combine Bowker et al. and Dunning et al. (or any other of the references) as proposed by the Examiner. "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385, 1397 (2007).

### 3. Conclusion

Applicants submit that one skilled in the art would not seek to combine Dunning et al. with Bowker et al. Even if Dunning et al. were to be combined with Bowker et al., the combination of references would not overcome the deficiencies of Bowker et al. Accordingly, it is submitted that claim 1 is patentably distinct from Bowker et al., alone or in combination with Dunning et al.

Claims 15 and 27 are other independent claims directed at sharing media data between computer programs. These claims also make use of a data communication file. As noted above, neither Bowker et al. nor Dunning et al. provide any teaching or suggestion for a data communication file to facilitate sharing media data between applications (or application programs) as recited in these claims. Therefore, it is submitted that claims 15 and 27 are patentably distinct from Bowker et al., alone or in combination with Dunning et al.

Dependent claims 2-4, 6, 9, 10, 13, 14, 16, 18-26 and 28-46 are also patentably distinct from the cited references for at least the same reasons as those recited above for the independent claim, upon which they ultimately depend. These dependent claims recite additional limitations that further distinguish these dependent claims from the cited references. For example, as to claims 38 and 43-46, the Examiner assertions on pages 14-17 of the final Office Action as without support and clearly predicated on hindsight. There is not basis to rationally conclude that one skilled in the art would have any need or motivation to combine Bowker et al. and Dunning et al. with either of Berry et al. or Health et al. Furthermore, none of these references provides any teaching or suggestion to update a data communication file as recited in claim 1.

For at least these reasons, these claims are patentably distinct from Bowker et al. in view of one or more of Dunning et al., Berry et al. or Health et al.

## C. Conclusion

For at least the above-notes reasons, it is submitted that claims 1-4, 6, 9, 10, 13-16 and 18-46 are patentably distinct from the cited references. Applicants respectfully request that the rejections under 35 USC § 103(a) be withdrawn.

Respectfully submitted,

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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 101-P288/P3054US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

| Application Number | Filed |
|---|---|
| 10/622,017 | July 16, 2003 |

First Named Inventor: David Heller

| Art Unit | Examiner |
|---|---|
| 2442 | Nickerson, Jeffrey L. |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 32947.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/C. Douglass Thomas/
Signature

C. Douglass Thomas
Typed or printed name

408-955-0535
Telephone number

October 28, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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